

REMARKS

Claims 1, 32-34, and 37 have been amended solely to overcome the rejection under 35 U.S.C. § 112, first paragraph, that they allegedly do not comply with the written description requirement on the basis of allegedly containing new matter. These claims are amended to delete usage of the "igniting" terminology, which is replaced with "combustion" terminology, as unmistakably supported by the specification. The amendments add no new matter.

Applicants respectfully request that the amendments after final be entered because they place the claims in better form for appeal. 37 C.F.R. § 1.116(b)(2).

The Claimed Subject Matter

The claimed subject matter relates to an alternative to traditional cigarettes, namely an electrically-heated cigarette, which is operable at lower temperatures than those involved in conventional, combusting cigarettes. As recited in claim 1, the "flavoring is releasable from the flavoring-release additive by heating the electrically heated cigarette to at least a minimum temperature within the electrical smoking system that generates tobacco smoke without combustion of the tobacco-containing mat." In one embodiment, it includes a flavoring-release additive in the form of film wherein the flavoring is releasable at a minimum temperature of about 50°C (claim 20). In another embodiment, the flavoring-release additive is in the form of beads and the minimum temperature is about 40°C (claim 12). Thus, it is apparent that the claimed invention

The Claims Comply with the Written Description Requirement

Claims 1-27 and 28-39 have been rejected under 35 U.S.C. § 112, first paragraph, for alleged failure to comply with the written description requirement on the basis of allegedly containing new matter. The present amendment obviates this new matter rejection.

The present amendment replaces the "igniting" terminology (rejected by the Examiner) with "combustion" terminology as fully supported by the original specification. The specification recites heating in a way "to allow smoking of the cigarette without combustion of the cigarette paper, mat, or tobacco" (paragraph 0092). This support in the specification has been acknowledged by the Examiner (Office Action dated December 29, 2006, page 2).

Accordingly, for the above reasons Applicants request reconsideration and withdrawal of the rejection of claims 1-27 and 28-39.

The Claims Comply with the Enablement Requirement

Claims 1-27 and 28-39 have been rejected under 35 U.S.C. § 112, first paragraph, for alleged failure to comply with the enablement requirement. Specifically, the Examiner asserts that "smoke" is defined to "invoke the process of ignition and burning" and that one of ordinary skill in the art would allegedly not be enabled to generate smoke without ignition (Office Action dated February 6, 2008, pages 2-3).

The Examiner did not make an enablement rejection of the claims when, as now, they recited "combustion" instead of "ignition" (Office Action dated July 24, 2007). Accordingly, because no enablement rejection was raised against the claims

in their current state, Applicants view the enablement rejection as moot, and respectfully request reconsideration and withdrawal thereof.

The Claims Comply with the Definiteness Requirement

Claims 1-27 and 28-39 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite.

First, the Examiner asserts that the recitation of generating smoke without igniting (now "without combustion") in claims 1, 33, and 34 is directed to the smoking system and not the cigarette itself (Office Action dated February 6, 2007, page 4). On the contrary, each of claims 1, 33, and 34 recites "wherein the flavoring is releasable ... by heating ... to at least a minimum temperature ... without combustion of the electrically heated cigarette" (emphasis added). Thus, the recitation in question is a proper limitation.

Second, the Examiner asserts that the limitation is an intended use (Office Action dated February 6, 2007, page 4). As noted above, the language in each of claims 1, 33, and 34 recites "wherein the flavoring is releasable ... by heating ... to at least a minimum temperature ... without combustion of the electrically heated cigarette" (emphasis added). Thus, the limitation in question is not merely an intended use.

Finally, the Examiner notes that the phrase is "ambiguous" and "provides no substantial limitation" (Office Action dated February 6, 2007, page 4). On the contrary, Applicants assert that one of ordinary skill in the art can easily ascertain the metes and bounds of the claims.

For all of the above reasons, the "without combustion" limitation is appropriate and definite, and Applicants respectfully request reconsideration and withdrawal of the rejection of the claims under § 112, second paragraph.

The Claims Are Novel Over Baggett

Claims 1, 2, 32, 33, 38, and 39 have been rejected under 35 U.S.C. § 102, as allegedly anticipated by Baggett et al. (U.S. Patent No. 6,026,820) (hereinafter "Baggett").

MPEP §2131 provides that a claim is deemed anticipated "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (emphasis added; MPEP quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2USPQ2d 1051, 1053 (Fed. Cir. 1987)). Thus, a proper *prima facie case of anticipation* requires that a single reference, provided by an Examiner, discloses each of the claimed elements as interpreted by one of ordinary skill in the art.

Applicants traverse the rejection and assert that a *prima facie* case of anticipation has not been established. Specifically, Applicants assert that Baggett does not disclose the electrically heated cigarette of any of claims 1, 2, 32, 33, 38, or 39, comprising: a flavoring-release additive including at least one flavoring, "wherein the flavoring is releasable ... by heating ... to at least a minimum temperature ... without combustion of the electrically heated cigarette" (emphasis added). Instead, Baggett recites "once pyrolysis is initiated in the fully-filled cigarette, it tends to be more self-sustaining, because of the presence of a greater mass of combustable tobacco" (col. 19 line 67 to col. 20 line 2) (emphasis added).

Because Baggett fails to teach all of the elements of claims 1, 2, 32, 33, 38, and 39, Applicants respectfully traverse and request withdrawal of the rejection of claims.

The Claims Are Nonobvious Over Baggett and McCarty in View of Shi

Claims 1-6, 8-15, 17-18, 20-22, 26, and 29-39 have been rejected under 35 U.S.C. §103(a) over Shi (U.S. Publication No. 2006/0000531) (hereinafter "Shi") in view of McCarty et al. (U.S. Patent No. 3,744,496) (hereinafter "McCarty").

Applicants traverse the rejection and assert that a *prima facie* case of obviousness has not been established.

Neither Shi nor McCarty disclose that a "flavoring is releasable ... by heating ... to at least a minimum temperature ... without combustion of the electrically heated cigarette" (emphasis added) as recited in each of the independent claims, namely claims 1, 33, and 34 (nor does the Examiner rely on McCarty or Shi to teach such), and they otherwise fail to cure the deficiencies of Baggett.

On the contrary, McCarty recites "a combustible porous paper sheet" and "cigar wrap having good combustibility" (emphasis added), and otherwise is plainly directed at combustible cigarettes.

Similarly, Shi is also directed at combustible cigarettes, referring to "when smoking material is combusted" (paragraph 0033).

Thus, because the cited references fail to teach the elements of claims 1-6, 8-15, 17-18, 20-22, 26, and 29-39, the claims are patentable over the cited art, and Applicants respectfully traverse and request reconsideration of their rejection.

The Claims Are Nonobvious Over Baggett and McCarty and Shi in View of Demain

Claims 23 through 25 stand rejected over Baggett and McCarty and Shi in view of Demain (U.S. Patent No. 5,144,946) (hereinafter "Demain").

Demain fails to disclose that a "flavoring is releasable ... by heating ... to at least a minimum temperature ... without combustion of the electrically heated cigarette" (emphasis added) as recited in each of the independent claims, namely claims 1, 33, and 34 (nor does the Examiner rely on Demain to teach such), and Demain otherwise fails to cure the deficiencies of Baggett, McCarty, and Shi.

On the contrary, Demain recites "a combustible filler and/or paper wrapper additive" (Abstract) (emphasis added).

Thus, because the cited references fail to teach the elements of claims 23-25, the claims are patentable and Applicants respectfully traverse and request reconsideration of their rejection.

Conclusion

For all of the above reasons, the claims are in condition for allowance.

Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

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